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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/621,058	07/21/2000	David W. Carman	NA11P080/99.123.01	4463
28875	7590	09/21/2004	EXAMINER	
Zilka-Kotab, PC P.O. BOX 721120 SAN JOSE, CA 95172-1120			HO, THOMAS M	
			ART UNIT	PAPER NUMBER
			2134	
DATE MAILED: 09/21/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/621,058

Applicant(s)

CARMAN ET AL.

Examiner

Thomas M Ho

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: 4 claims were canceled while 15 new claims were added.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☒ affidavit, b) ☒ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

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The Extra claims introduce the new element of a system including a manager, and a system including a local security and resource manager which are new claim elements not previously mentioned in the prior claims.

Continuation of 5. does NOT place the application in condition for allowance because: evidence of reduction to practice and diligence is not presented, while the exhibit presented as evidence of conception is not mapped to any of the claimed elements.

See attached
examiner's response
for detail.



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EXAMINER'S RESPONSE

The affidavit filed on 7/15/2004 under 37 CFR 1.131 has been considered but is ineffective to antedate the Bellare et al. and Black et al. reference.

The affidavit submitted by applicant has not been properly signed and executed by the party of interest. The list of signature(s) provided by the applicant in the submitted affidavit discloses only "David W. Carman". However, the signatures the other inventors of the application, Michael D. Heyman and Alan T. Sherman, are absent. MPEP 715.04, Section I states

A) All of inventors of the subject matter claimed should make the declaration under 37 CFR 1.131.

B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim of claims under rejection.

However, as applicant has failed to disclose any information revealing that only David W. Carman invented the claim(s) in question, the affidavit is deficient in this regard as well.

Exhibit A, appears to be a document revealing the details of a project from which Applicant's application and claims stem. However, only a general allegation of presence of the elements of the claims is made in Exhibit A. The Examiner acknowledges the possibility of evidence of conception, as can be inferred from previous communications. However, the format of the affidavit in disclosing evidence of conception is improper. *"The affidavit or declaration*

and exhibits must clearly explain which facts or data applicant is replying on to show completion of his or her invention prior to the particular date.” See MPEP 715.07, Section I.

The evidence submitted is furthermore insufficient to establish diligence from a date prior to the date of reduction to practice of the Black et al. reference to either a constructive reduction to practice or an actual reduction to practice. With regards to diligence, Applicant has declared the following in Item 4.

- “It is hereby declared that applicant acted diligently up to reduction to practice or the filing of the above patent application”

However, Applicant has presented no factual evidence of diligence. See MPEP 715.07(a).

Furthermore, the document as revealed by the Applicant, fails to establish evidence of actual reduction to practice. A declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion is insufficient to satisfy 37 CFR 1.131.

“The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice “amounts essentially to mere pleading, unsupported by proof or a showing of facts” and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are

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established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.")." See MPEP 715.07, Section I.

Accordingly, applicant is only entitled to his filing date (constructive reduction to practice) when considering the date of a prior art reference.



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